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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/753,591 | 01/03/2001 | Jesse A. Jurens | 29-0803 | 1866 |
| 40158 7590 02/11/2009 WOODS FULLER SHULTZ & SMITH P.C. ATTN: JEFFREY A. PROEHL P.O. BOX 5027 SIOUX FALLS, SD 57117 | | | | |
| EXAMINER RODRIGUEZ, PAMELA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3657 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/753,591

Applicant(s)

JURRENS, JESSE A.

Examiner

Pam Rodriguez

Art Unit

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-43 and 46-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-43 and 46-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 11, 2008 has been entered.

Claim Objections

2. Claim 67 is objected to because of the following informalities: in line 2 of the Claim, the word "define" should read --defines--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 38-43 and 46-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,129,634 to Harris in view of U.S. Patent No. 3,603,611 to Wenhham.

Regarding Claim 38, Harris discloses a suspension device (see Figure 1) capable of connecting to a frame of a vehicle and a swing arm on which a wheel of the vehicle is mounted having most all the features of the instant invention including: a housing 40 defining an interior, a shock absorber 20/30/14 mounted on the housing (see Figure 1), the shock absorber including a rod 20 movably mounted on the housing 40 (at least through its connection to element 30 and element 26) such that at least a portion of the rod 20 extends into the interior of the housing and through the housing (see Figure 1 and the lower portion of rod 20 which extends through cylinder 18 and thus also through housing portion 40), a piston 14 positioned in the interior of the housing 40 and being mounted on the rod of the shock absorber to move with the rod (note that the piston is readable as being mounted on rod 20 at least through element 18, see also Figure 5 of the reference), an air bag 30 positioned within the interior of the housing 40 (see Figure 1), the air bag being constructed of an elastomeric material, the air bag 30 having a first end 28 mounted on the housing in the interior of the housing at element 32 and a second end 34 mounted on the piston 14 such that the piston, the housing, and the air bag collectively define an air chamber within the housing (see Figure 1).

However, Harris does not disclose that his housing completely encloses the air bag.

Wenham is relied upon merely for his teachings of an air bag suspension system (see the Figure) forming a shock absorber 5 which includes at least one air bag, the air

bag is completely enclosed within a housing assembly (see the Figure and the outer housing for the air bag of assembly 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension system of Harris to include an air bag enclosed completely within a housing assembly as taught by Wenham as an effective means of sealing the air bag from the environment. By constructing the air bag to be fully enclosed within the housing assembly, outside dirt, debris, and other such contaminants would be prevented from damaging the air bag.

Regarding Claim 39, see ends 28 and 34.

Regarding Claim 40, see flange 32 and flange 34 and column 3 lines 55-58.

Regarding Claim 41, see portion 28 which receives a portion of an end cap 26 of the housing and portion 34 receiving piston 14.

Regarding Claim 42, see Figure 1.

Regarding Claim 43, see shock absorber 18 which inherently includes a hydraulic piston and a cylinder, at least a portion of the cylinder mounted in housing 40 and the piston would inherently be mounted on rod 20, wherein the rod is certainly capable of being configured to be mounted on one element of the frame or the swing arm and the cylinder is certainly capable of being mounted on the other of the frame or swing arm.

Regarding Claims 46, 47, and 66, see Claim 38 above and note how the housing of Wenham shown in the Figure abuts against an entire circumference and entire length of the air bag, when the air bag is fully extended as shown in the figure.

Regarding Claim 48, Harris discloses that a degree of pressurization of the pressurized air in the air-bag suspension member 10 is adjustable (see column 6 lines 13-31).

Regarding Claim 49, Harris inherently discloses that the air-bag suspension member is characterized by a support spring force which is a function of compression stroke.

Regarding Claim 50, see column 6 lines 13-31 of Harris.

Regarding Claims 51 and 53, Harris, as modified, discloses most all the features of the instant invention as applied above except for the specifics of the support spring force being a progressive function of compression stroke or an exponential function of compression stroke.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the air bag suspension member of Harris, as modified, so that the support spring force is either a progressive function or an exponential function of compression stroke as a matter of design preference dependent upon the desired damping characteristics of the suspension system. As long as the spring force is correlated to the compression stroke to provide adequate damping to the air bag system, their relationship to one another is arbitrary.

Regarding Claim 52, see column 6 lines 13-31 of Harris, where inherently this limitation would be true.

Regarding Claims 54 and 60, see Claim 48 above.

Regarding Claims 55 and 61, see Claim 49 above.

Regarding Claims 56 and 62, see Claim 50 above.

Regarding Claims 57, 59, 63, and 65, see Claims 51 and 53 above.

Regarding Claims 58 and 64, see Claim 52 above.

Regarding Claim 67, Harris, as modified, further discloses that the piston 14 defines a cavity (see Figure 1) located opposite of the air chamber that is capable of receiving a portion of the shock absorber 18 upon compression of the suspension device (see Figure 1).

Response to Arguments

5. Applicant's arguments with respect to claims 38-43 and 46-67 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,022,448 to Reeder discloses a suspension device similar to applicant's having an air bag substantially fully enclosed in a housing.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 571-272-7122. The examiner can normally be reached on Mondays 5:30 AM - 4 PM and Tuesdays 8 AM - 2 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rob Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pam Rodriguez
Primary Examiner
Art Unit 3657

/Pam Rodriguez/
Primary Examiner, Art Unit 3657
02/09/09